

REMARKS

Summary of Action

In the subject office action, the Examiner rejected

(a) claims 1, 5 and 11 under 35 USC 112 first paragraph, as containing subject matter which was "not described in the specification in such a way as to enable one skilled in the art ... to make and/or use the invention";

(b) claims 1, 5 and 11 under 35 USC 102(b) as being anticipated by Maxwell (USP 5,805,810); and

(c) claims 2, 6, 8, 9 and 13 under 35 USC 103 as being unpatentable over Maxwell in view of Yacoub (USP 6,452,692) and Heiden (USP 6,408,286) combined; and

(d) claims 23, 10, 15 under 35 USC 103 as being unpatentable over Maxwell in view of Yacoub and Heiden (USP 6,408,286).

Rejection of claims 1, 5, 11 under 35 USC 112 first paragraph

In response to the Examiner's rejection, Applicants submit herewith the declaration of Al Simon, a person of ordinary skilled in the art declaring under the penalty of perjury that he has read the application, and he believes he can practice the invention as claimed without undue experimentation.

Accordingly, withdrawal of the rejection is respectfully requested.

Rejection of claims 1, 5 and 11 under 35 USC 102(b)

In response, Applicants traverse the Examiner's rejection.

For a reference to be an effective 102(b) rejection, the patent/application must be issued/published a year prior to the effective filing date of the present application.

The effective filing date of the present application is March 19, 1999. The '810 patent (Maxwell) was issued on Sep 8, 1998, less than one year earlier. Accordingly, Maxwell is an ineffective 102(b) reference.

As a possible 102(a) reference, Maxwell nevertheless fails to teach at least one element of independent claims 1, 5, and 11. Specifically, it fails to teach the required elements of "compar(ing) the message recipient physical address with a plurality of printing locations, (and) select(ing) one of the printing locations based at least in part on the results of said compare(ing)".

In the rejection, the Examiner asserted that the elements were taught in the passage starting from col. 13, line 33 to col. 14, line 67. Respectfully, the Examiner is incorrect.

Applicants assume the Examiner's incorrect conclusion is probably based on the passage in col. 14, lines 17-22, where it is stated "The present invention, thus, permits, a sender located in one country (e.g. Brussels) to send a letter (i.e. netgram) to a recipient in another country (e.g. U.S.), eliminated the need to use international postal services (i.e. the postal service of both countries) and minimizing postal charges resulting from using international postal services".

It is clear the passage does not explicitly include the above enumerated required elements of claims 1, 5 and 11.

Thus, the issue is whether the passage can be read as inherently teaching the enumerated required elements. Applicants respectfully submit it does not, as the alleged savings can be achieved by a user (from e.g. Brussels), sending a letter to a recipient in another country e.g. United States, where the printer server is located.

Applicants submit this is actually the correct reading of the passage, as it is well settled that the meaning of a portion of a reference must be read in a manner that is consistent with other portions and the totality of the teachings of the reference.

As set forth in the last response, Figure 2 of Maxwell and its corresponding descriptions merely disclosed the employment of a single print server having a print queue processor. Starting on or about col. 7, line 60, and running through col. 11, line 46, Maxwell disclosed a Message Validator for use to validate a received electronic message. Starting on or about col. 10, line 32, Maxwell disclosed that when “no exception messages” have been generated as part of the “validation” process, and after building and queuing for transmission an “accept” message for the sender, the Message Validator builds a mail object (“the message”) and queues the mail object in the print queue for printing.

Starting on or about col. 12, line 38, running through col. 13, line 10, Maxwell disclosed the operation of the print queue processor.

Nowhere in these descriptions of Maxwell can Applicants find any teaching on the required operations of *“comparing the message recipient physical address to a plurality of printing locations, and selecting a printer location based at least in part on the result of the comparison”*.

Thus, Applicants submit that the only way the passage can be read as having anticipated the enumerated required elements is by reading the passage, in view of Applicants' teachings, which is an impermissible use of hindsight.

Accordingly, withdrawal of the rejections is respectfully requested.

Rejection of claims 2, 6, 8, 9 and 13 under 35 USC 103

Claims 2, 6, 8, 9 and 13 depend on claims 1, 5 or 11 incorporating their limitations. Therefore, for at least the same reasons, claims 2, 6, 8, 9 and 13 are patentable over Maxwell. Yaucob does not remedy the above described deficiency in teachings of Maxwell. Thus, claims 2, 6, 8, 9 and 13 remain patentable even when Maxwell is combined with Yaucob.

Moreover, as discussed in the last response, Yacoub teaches a print server for printing jobs on networked printers. The print server receives preferences regarding a print job the user wishes to send such as speed and image quality. The server determines, using a database or other query, the most appropriate printer complying with the print job preferences that is located physically near the user (sender of the print job), and spools the print job to that printer. See e.g. the Abstract. In col. 6, lines 25-48, Yacoub further describes this operation of selecting a printer that is located physically near the user (sender of the print job), by computing the distance between the locations of the user (sender of the print job) and a printer candidate, using their respective coordinates.

Accordingly, even if we assume Yacoub's print job may be equated with the printing of a message being sent from a sender to a recipient, the "proximity" analysis performed in Yacoub is nevertheless a "proximity" analysis of the locations of the user (i.e. sender of the print job) and the printers, and not the required "proximity" analysis of the locations of the recipient and the printers.

Yet further, Applicants respectfully remind the Examiner that section 103(a) requires that the invention be viewed as a whole. The court has repeatedly admonished on the necessity of the cited references to contain suggestion of the modifications and combinations, or the motivation to modify and combine is readily in possession of those of ordinary skill in the art.

For the issues at hand, Applicants submit there is no disclosure in either Maxwell nor Yacoub to suggest first modifying the "proximity" analysis of sender and printer locations to "proximity" analysis of recipient and printer locations, and then further extending the modified "proximity" analysis from the disclosed network print application to a mailing application, where the printed materials are known to have to be mailed.

Applicants also submit such motivation is not readily in possession by one of ordinary skill in the art. If the Examiner asserts to the contrary, the Examiner is obligated to provide support for his position.

Rejections of claims 3, 10 and 15 under 35 USC 103(a)

Claims 3, 10 and 15 depend on claims 1, 5 or 11 incorporating their limitations. Therefore, for at least the same reasons, claims 3, 10 and 15 are patentable over Maxwell. Neither Yacoub nor Heiden remedies the above described deficiency in

teachings of Maxwell. Thus, claims 3, 10 and 15 remain patentable even when Maxwell is combined with Yaucob and Heiden.

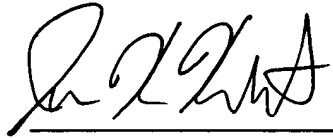
Conclusion

In view of the foregoing, Applicants respectfully submit that claims 1-6 and 8-15 are all in condition for allowance, and early issuance of the Notice of Allowance is respectfully requested.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
Applicants

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IPG No: P001

Patent



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Zehr et al

Application No.: 09/581,306

Filed: July 7, 2000

Priority Date: March 19, 1999

For: Distributed System For Conducting
Physical Delivery Mail Service
Over The Internet

Examiner: Salad, Abdullahi Elmi

Art Unit: 2157

CERTIFICATE OF TRANSMISSION/MAILING

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Typed or Printed: Heather L. Adamson

Signature: Heather L. Adamson Date: 02/27/04

Commissioner for Patents
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Declaration of Al Simon

Sir:

I, Al Simon, hereby declare that:

1. I am a citizen of the United States of America, and currently a resident of
the State of Oregon, residing in or around the greater Portland metropolitan area.

2. I am a person of ordinary skill in the art of Software Engineering. I am
College educated in the field, and I've working in the capacity of a Software
Engineer for approximately 19 years.

3. I have read the captioned application, and I believe I am able to practice
the invention as claimed, based on the descriptions of the invention provided
therein, without further experimentation. In particular, I believe I am able to practice

the aspect of the invention involving "comparison of a message recipient's address with printer locations, and selecting an appropriate printer to print the message based at least in part on the result of the comparison", without further experimentation. For examples, I can practice the foregoing aspect by associating the printer locations with zip codes of the locations, and perform the comparisons based on the zip codes; alternatively, I can associate the printer locations with geographic coordinates, and perform the comparisons based on the geographic coordinates, by looking up the geographic coordinates of the recipient addresses from a geographic database using the recipient addresses.

I further declare that all statements made herein of my own individual knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Executed by and on the date(s) as set forth below:

By: 

Al Simon

Date: 26-Feb-04